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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,143	12/02/2003	David K. Swanson	03-0312 (US01)	5314

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EXAMINER	
ROANE, AARON F	

ART UNIT	PAPER NUMBER
3739	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ED

Office Action Summary	Application No.	Applicant(s)	
	10/727,143	SWANSON, DAVID K.	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,27-40,42-44 and 46-54* is/are pending in the application.

4a) Of the above claim(s) *7,37 and 38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-10,27-36 and 39-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-10, 27-29, 31-35 and 37-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman et al. (USPN 6,010,500).

Regarding claims 1, 27 and 47, Sherman et al. disclose a source of coagulation energy (29); a source of stimulation energy (inherent); and a surgical probe (10), adapted to be operably connected to the source of coagulation energy and the source of stimulation energy, including a relatively short shaft (ranging from a point proximal of the most proximal 32 to the distal end of 12) defining a distal region and a proximal region; a coagulation element (coagulation means) (18) defining a coagulation element configuration on the distal region of the relatively short shaft; and a stimulation element

(stimulation means) defining stimulation element (38a and 38b) configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element configuration, see col. 3, line 66 though col. 7, line 38 and figures 1-6. It should be further noted that the relatively short shaft is tubular.

Regarding claims 2-6 and 31-34, Sherman disclose the claimed invention, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claims 8, 35 and 48, Sherman et al. disclose an embodiment wherein the relatively short shaft is malleable, see col. 8, line 21 through col. 9, line 14 and figures 14-17D.

Regarding claims 9 and 49, Sherman et al. further disclose a handle (portion adjacent 24 and 27) associated with the proximal region of the relatively short shaft, see figure1.

Regarding claims 10 and 50, Sherman et al. further disclose the stimulation element is located distally of the coagulation element, see element 38a in figures 5 and 6.

Regarding claim 28, Sherman et al. further disclose a coagulation energy line (26) connected to the coagulation element and to a coagulation energy connector (27) configured to be connected to the source of coagulation energy; and a stimulation energy line (inherent) connected to the stimulation element and to a stimulation energy connector

(inherent) configured to be connected to the source of stimulation energy, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claim 29, Sherman et al. disclose the claimed invention, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claims 39 and 43, Sherman et al. further disclose the coagulation element and the stimulation element are carried on the relatively short shaft such that the coagulation element and the stimulation element longitudinally fixed relative to one another, see col. 3, line 66 though col. 7, line 38 and figures 1-6 and claims 10-12.

Regarding claims 40-42 and 44-46, Sherman et al. disclose the claimed invention, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claims 51-54, Sherman et al. disclose a handle that is both linear and coaxial with the shaft, see figures 1-11.

Claims 1, 27, 28, 30, 36, 39 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Hooven (USPN 6,889,694).

Regarding claims 1 and 27, Hooven discloses a source of coagulation energy (114);

a source of stimulation energy (inherent); and a surgical probe (110), adapted to be operably connected to the source of coagulation energy and the source of stimulation energy, including a relatively short shaft (116) defining a distal region and a proximal region, a coagulation element (120) defining a coagulation element configuration on the distal region of the relatively short shaft, and a stimulation element (172, 174) defining a stimulation element configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element configuration, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66. It should be further noted that Hooven discloses the relatively short shaft (116 and 118) that are tubular, see figures 41-46.

Regarding claim 28, Hooven further discloses a coagulation energy line (within 112) connected to the coagulation element and to a coagulation energy connector (part of proximal connector of 112 that has a mating structure on 114) configured to be connected to the source of coagulation energy; and a stimulation energy line (within 112) connected to the stimulation element and to a stimulation energy connector (part of proximal connector of 112 that has a mating structure on 114) configured to be connected to the source of stimulation energy, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66.

Regarding claim 30, Hooven further discloses a handle (140) associated with the proximal region of the relatively short shaft; wherein the coagulation energy connector is

carried by the handle and the stimulation energy line extends through the handle, see figure 33.

Regarding claim 36, Hooven discloses the claimed invention, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66.

Regarding claims 39 and 43, Hooven further discloses the coagulation element and the stimulation element are carried on the relatively short shaft such that the coagulation element and the stimulation element longitudinally fixed relative to one another, see figure 66.

Response to Arguments

Applicant's arguments filed 4/26/2007 have been fully considered but they are not persuasive. The examiner will address each argument/remark in turn.

On page 8, next to last paragraph Applicant asserts "Sherman fails to disclose, teach or suggest a coagulation element.., on the distal region of the same relatively short tubular shaft" and "a stimulation element ... on the distal region of the same relatively short tubular shaft" as recited in claims 1 and 27 and means for coagulating tissue "on the distal region of the same relatively short tubular shaft" and means for stimulating tissue "on the distal region of the same relatively short tubular shaft" as recited in claim 47." The examiner strongly disagrees.

Applicant admits on the record that Sherman "describes a catheter device 10 having "an inner shaft 12 and an outer shaft 14." Sherman (col. 4, lines 1-2). "Inner shaft 12 extends telescopically through the outer shaft 14." Sherman (col. 4, lines 2-3)." It should be noted that the outer shaft is disposed on the inner shaft and it is this positional and functional relationship that provides for both the coagulation and stimulation elements being on the distal end of the relatively short tubular shaft (inner shaft). Furthermore, the word "same" nowhere appears in any of the claims. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Regarding Applicant's assertion that "Sherman fails to disclose, teach or suggest "wherein the coagulation energy connector and stimulation energy connector define different configurations" as recited in claim 29. The Office Action generally refers to col. 3, line 66 - col. 7, line 38 and six different figures to support the rejection, but does not specifically identify connectors defining different configurations," see 3rd full paragraph on page 9. Within the recited passage of Sherman et al., it mentions the necessary coagulation connector that is connected to more than two coagulation electrodes and a stimulation connector connected to only two electrodes. In the very broad since that one connector connects to more than two electrodes and the other connects to only two electrodes, the connectors are inherently of distinct configuration.

Regarding Applicant's argument/remarks on page 10, 1st full paragraph, the examiner interprets the outer surface of the inner shaft as the unitary outer member.

Regarding Applicant's arguments/remarks refuting Hooven clearly shows the recited tubular shaft, see rejections above and figures 41-46.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Roy D. Gibson

ROY D. GIBSON
PRIMARY EXAMINER

Aaron Roane A. R.
June 11, 2007